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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/187,332	11/06/98	NAYLOR	J JFX/027-98
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TM02/1105

RICHARD T LYON
LYON HARR & DEFRANK
300 ESPLANADE DRIVE
SUITE 800
OXNARD CA 93030

EXAMINER

HARRELL, R

ART UNIT

PAPER NUMBER

2152

13

DATE MAILED:

11/05/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

SM

Office Action Summary

Application No.
09/187,332

Applicant(s)
Naylor et al.

Examiner
Robert B. Harrell

Art Unit
2152



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/13/01
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☒ The proposed drawing correction filed on 8/13/01 is: a) ☒ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☒ Other: attached office action.

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1. Claims 1-18 remain for examination.
2. The applicant's amendment to figure 1 is accepted.
3. The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this office action:
 - a) a patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103, examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligations under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. 102 (f) or (g) prior art under 35 U.S.C. 103.
5. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ho et al. (5,805,298) alone or in view of Fabbio et al. (5,870,089).
6. Ho taught the invention substantially as claimed, including a process for sending electronic mail or facsimiles (eg., see Abstract) from a facsimile machine (100 in figure 1 (eg., see figure 2, col. 3 (lines 27-32)) comprising the steps of:
 - a) a user entering into the facsimile machine a facsimile

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telephone number (eg., see col. 6 (lines 31-35)) and an electronic mail address (eg., see col. 6 (lines 35-48)) corresponding to a same recipient;

b) the user placing a document to be transmitted into a facsimile machine (eg., see figure 1 (101,204), col. 4 (lines 10-19));

c) the fax machine storing the facsimile telephone number or electronic mail address in a memory location in a memory of the facsimile machine (eg., see col. 5 (line 40-et seq.));

d) associating an actuator ("Send Button") disposed on the facsimile machine (eg., see figure 2(a)) to the memory location containing the facsimile telephone number and electronic mail address (eg., see figure 3 and col. 6 (line 23-et seq.)); and,

e) the user activating the actuator to transmit a facsimile to the facsimile telephone number or electronic mail to the electronic mail address (eg., see col. 6 (lines 27-41) and col. 7 (lines 6-17)).

7. While Ho did not specifically send the message via both by facsimile and e-mail, such would have been obvious to those skilled in the art when taken Ho alone. That is, the message could first be sent by e-mail and then latter by facsimile or at the same time. Furthermore, on line 2 of Ho's abstract, in col.

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1 (lines 46-53), and in col. 2 (lines 19-22) Ho suggested transmitting in both facsimile and electron mail. Since his device could do both, doing both at different times or at the same time would have been obvious to those skilled in the art. Also, sending the message by facsimile and e-mail would have been obvious to those skilled in the art when taking Ho in view of Fabbio who taught of sending electronic mail and facsimile (eg., see col. 3 (lines 4-23)) at the same time. Also, the claims of this application fails to teach at what moment (ie., at the same time) the electronic mail is transmitted with respect to the facsimile of the message (ie., a time lag is also covered by the claims).

8. It would have been obvious to have combined these references because they were both directed to sending electronic mail and facsimile to a recipient from a single device. Furthermore, col. 6 (lines 32-36) of Fabbio stated that the delivery service system 12 of figure 2 could be either a stand alone computer or a local area network (LAN) as called for by Ho in col. 3 (line 54) to col. 4 (line 6). Since Ho called for a LAN version, and Fabbio taught a LAN version, it would have been obvious to those skilled in the art to use Fabbio's system in Ho's system (specifically delivery server 12 of Fabbio's second figure for the PSTN 106

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in Ho's first figure).

9. Per claim 2, Ho taught that his actuator was a button (eg., see figure 2(a)) and buttons are switches.

10. Per claims 3 and 4, Ho taught that electronic mail was sent via a server (SLIP/PPP (ie., an Internet Service Provider)) and facsimile was sent to the recipient via a PSTN 106 in figure 1 and col. 3 (lines 32-43). A PSTN is a Public Switch Telephone Network having several computers. Also, Fabbio taught that the delivery server 12 was a server.

11. Per claim 5, such is standard facsimile operations and was taught in Ho at col. 6 (line 27-et seq.)).

12. Per claim 6, while the device (100) performed these functions (ie., if there is a phone number the message was faxed or if it where an e-mail address the message was sent via e-mail) (eg., see Ho's col. 6 (lines 31-38) and col. 7 (lines 6-17)).

13. Per claim 7, while PSTN has been addressed, Ho taught of the use of the Internet (eg., see figure 1 (112)) which is a wide area network.

14. Per claims 8-18, these do not teach and define above the corresponding claims and are thus also rejected for the reasons outlined above.

15. In conclusion, Ho taught the invention as claimed except for

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send both the fax and e-mail "at the same time". But since Ho could either fax or e-mail one or the other, Ho had the means for sending them at the same time. Thus, in light of Fabbio, sending a fax and an e-mail at the same time in Ho would have been obvious to those skilled in the art.

16. Per the applicant's remarks filed 8/13/01 (paper #6), the applicant argued in substance that:

a) it was not obvious to those skilled in the art at the time the invention was made to send a message both via facsimile and e-mail. It is the applicants' position that there is no motivation to modify Ho to send the message via both facsimile and e-mail at the same time because such a combination would destroy the stated function of the Ho invention. However, there is no temporal limitations with respect to data transmission. The claims fail to state "at the same time" or the like. Specifically, taking claim 1 as an example, the claim states "the user activating said actuator to transmit a facsimile to the facsimile telephone number and electronic mail to the electronic mail address." Thus, the scope of first sending the facsimile to the facsimile telephone number and upon completion sending the electronic mail to the electronic mail address at some later point in time reads on the claim(s) as taught by Ho. Also, it

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would have been obvious to those skilled in the art to have modified Ho such that both could be transmitted at exactly the same time (ie., use the add additional phone lines indicated in figure 1 (element 106 "SLIP/PPP" and "PSIN")). Moreover, Fabbio clearly taught, with respect to figure 2 (FAX and E-MAIL), that the document could be sent, at the exact same time, to both a facsimile telephone number and e-mail address as indicated in the Abstract (last 4 line "destinations" in the plural), col. 3 (lines 4-23, specifically line 22 "at the same time"). Thus modifying Ho to use the additional lines of figure 1 (106) to send both the facsimile message and an e-mail message at the same time would have been obvious because he could send facsimile messages and e-mail messages. Furthermore, Fabbio clearly taught that sending such messages at the same time was known to those skilled in the art. Hence, one skilled in the art having knowledge of Fabbio would have been motivated to have send the messages at the same time in Ho since Ho had the functionality of sending facsimile and e-mail over the different lines (e-mail via SLIP/PPP and fax via PSIN);

b) Ho's invention can only send e-mail or facsimile messages at different times. However, the scope of the claims also falls within this reading since they fail to recite such a limitation

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as suggested by the argument (ie., "at the same time"). First sending the facsimile, and then at some latter point in time, be it because of errors or not, the e-mail is then sent reads on "transmit a facsimile to the facsimile telephone number and" [at some other point latter in time send the] "electronic mail to the electronic mail address." (from claim 1). As can be seen, adding the limitations in the brackets more narrows the scope and while removal of this limiting teaching wideness the scope. Thus, since Ho reads on the claimed invention in the more narrow scope Ho clearly reads on the less narrow scope of the claim;

c) it is well settled in the law that a rejection based on a modification of prior art that destroys the function of the invention disclosed in the prior art is improper and does not establish a prima facie case of obviousness. However, the modification would not destroy any functions of Ho but supplements such functions. While Ho functions to normally deliver the facsimile in the normal manner as disclosed by Ho, the additional lines present can be used to deliver the e-mail at the same time with the facsimile. There is no loss of function in Ho, the function is complemented with additional functions.

17. For all the reasons given above, sending facsimile messages and e-mail messages in Ho over the two lines at the same time

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would have been obvious to those skilled in the art when viewing Ho alone, or more specifically, clearly obvious while viewing Ho in light of Fabbio. Also, those skilled in the art would have clearly noticed that while the PSTN (106 of figure 1) was used for transmitting a facsimile message, the SLIP/PPP would stand idle and thus one would have been motivated to use that line at the same time for sending e-mail while the facsimile was being sent. Additional usage of the SLIP/PPP would not destroy the sending of the facsimile message while the e-mail message was being sent at the same time. When reviewing Fabbio (figure 7 (146)) with respect to Ho, one would have understood the obvious need to enter more than one destination. Finally, the claims fail to provide any temporal order as to when the messages are transmitted, they could be at the exact same moment or at different points in time.

18. THIS ACTION IS MADE FINAL. The applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

19. A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CFR 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE

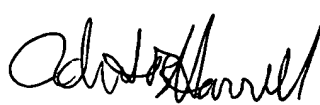
STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM
THE DATE OF THIS FINAL ACTION.

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20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Harrell whose telephone number is (703) 305-9692. The examiner can normally be reached Monday thru Friday from 5:30 am to 2:00 pm and on weekends from 6:00 am to 12 noon Eastern Standard Time.

21. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart, can be reached on (703) 305-4815. The fax phone number for the Group is (703) 308-7201.

22. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.



ROBERT B. HARRELL
PRIMARY EXAMINER
GROUP 2152